

## REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 1-6 and 9-13 are rejected under 35 USC 102(b) over the U.S. patent application publication to Larson.

After carefully considering the Examiner's grounds for rejection of the claims over the art, applicant amended Claim 1, the broadest claim on file, so as to more clearly define the present invention and to distinguish it from the prior art.

Turning now to the prior art applied by the Examiner, and in particular to the Larson reference, it is respectfully submitted that this reference discloses an overload clutch with a first (108) and a second (107) clutch means for an electric hand machine tool, wherein the first clutch means (108) is force-connected to a hub (110) which is arranged on an output shaft (101). Moreover, the first clutch means (108) is configured as a plurality of slip clips which are arranged in the second clutch means (107) which is embodied as clip holder and is connected in a torque-proof fashion due to an extending leg (114) with an input gear (106). In addition, the clip holder (107) comprises a retaining member (124) which engages in an opening of the slip clips (108) and is provided to connect the slip clips (108) in a torque-proof manner with the clip holder (107).

To apply a torque from the slip clips (108) to the hub (110) the slip clips (108) to the hub (110) the slip clips (108) encompasses the hub (110) at a slip face (118). Due to the chosen materials of an inner diameter face (116) of the slip clips (108) and the slip face (118) of the hub (110) there is provided an adhesion between the inner diameter face (116) and the slip face (118) in a normal working modus. In an event of an overload, e.g. in case of a jamming of the output shaft (101), the static friction of the inner diameter face (116) and the slip face (118) changes to a kinetic friction, and thus the inner diameter face (116) of the slip clips (108) slips on the slip face (118) of the hub (110). As a result an overload could be prevented (as disclosed in Larson et al., paragraphs [0032] and [0057] to [0062] as well as in figure 4).

The Larson et al. reference does not disclose that the retaining member (124) expands the slip clips (108) elastically in an event of a jamming of the output shaft (101).

It is therefore believed to be clear that this reference does not disclose the new features of the present invention as defined in amended Claim 1.

The original claims were rejected over this reference under 35 USC 102(b) as being anticipated. In connection with this it is believed to be advisable to cite the decision In Re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the device disclosed in the Larson reference does not include each and every element of the present invention as now defined in amended Claim 1.

Therefore, it is respectfully submitted that the Examiner's rejection of the claims as being anticipated by the Larson reference should be considered as not tenable and should be withdrawn.

It should be further emphasized that the Larson et al reference does not provide any hint, suggestion, or motivation for the new features of the present invention, which can make the present invention obvious from the teaching of the reference. The Larson et al. reference teaches to construct an overload clutch, wherein in an event of an overload a first clutch means (108) configured as a plurality of slip clips with an inner diameter face (116) slips over a corresponding slip face (118) of a hub (110). This gliding or this kinetic friction, respectively, is achieved due to purposefully chosen materials of the involved components.

In contrast to the teaching of the Larson et al. reference is the teaching of the present patent application. The patent application claims an overload clutch with a driving feature (24), wherein this driving feature (24) expands a first clutch means (26) in an event of a jamming of an output shaft (20) elastically. Due to this mechanism or

the expansion of the first clutch means (26), respectively, an overload clutch can be provided, that is constructed in an easy fashion and acts in an event of an overload reliably and with a low wear, especially of the first clutch means (26) (see patent application, page 2, line 3). A connection of the first clutch means (26) with the output shaft (20) in a force-dependent manner could be reliably interrupted due to the expansion of the first clutch means (26), which results in a secure break of a flux of force from an electric motor to a drive (see page 2, line 28 to page 3, line 1 of the patent application). According to the expansion, only a minimal friction occurs between the first clutch means (26) and the output shaft (20) that leads to an advantageous protection of the contact surfaces of the first clutch means (26) and the output shaft (20). Therefore, longer service intervals and thus longevity of the overload clutch can be profitably achieved.

The Larson et al. reference does not disclose that the slip clips (108) are elastically expanded in the case of an overload. Rather, it discloses a changing from a static friction into a kinetic friction only to uncouple the connection between the slip clips (108) and the hub (110). Thus, the Larson et al. reference has the disadvantage that the inner diameter face (116) of the slip clips (108) and the slip face (118) of the hub (110) are exposed to a very high friction in the case of an overload, which leads in the event of a trigger of the overload clutch to a high wear of material at the inner diameter face (116) and the slip face (118).

It is therefore believed to be clear that the present invention provides for the highly advantageous results which cannot be accomplished by the device disclosed in the Larson et al reference. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case Ex parte Tanaka, Marushma and Takahashi (174 UPSQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of the ordinary skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

As can be seen from the above presented analysis, the Larson et al reference does not contain any hint, suggestion, or motivation for the new features of the present invention which are now defined in amended Claim 1. In order to arrive at the applicant's invention from the teaching of the reference, the reference has to be fundamentally modified, and in particular by including into it the new features of the present invention which are now defined in amended Claim 1, that were first proposed by the applicant. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above presented remarks and amendments it is believed that Claim 1, the broadest claim on file, should be considered as patentably distinguishing over the art and should be allowed.

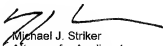
As for other claims, these claims depend on Claim 1, they share its allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion

might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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